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10/796,695	03/08/2004	Wayne D. Young	19680-009000US	2868

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TOWNSEND AND TOWNSEND AND CREW, LLP  
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SAN FRANCISCO, CA 94111-3834

EXAMINER
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RICHER, AARON M

ART UNIT	PAPER NUMBER
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2628

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12/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WAYNE D. YOUNG

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Application No. 10/796,695  
Technology Center 2600

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Mailed: December 17, 2008

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Before PAMELA S. BENNETT, *Review Team Paralegal*  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on December 2, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

**APPEAL BRIEF, GROUNDS OF REJECTION**

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed February 4, 2008 under the heading “Grounds of rejection to be reviewed on appeal” is unclear and/or is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified.

A review of the last Office action (Final Rejection mailed May 8, 2007), including any mailed Advisory Action(s), finds that:

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quintana in view of Keithley (U.S. Patent Number 6,028,677) [page 10];

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quintana in view of Keithley and further in view of Li (U.S. Patent 6,563,957) [page 11]; and

Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quintana [page 12].

However, Appellant has either not indicated the grounds of rejection of these claims or has improperly listed these claims as “[d]ependent claims 6-9, 16, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Quintana in view of Kiethley [sic] , Li, U.S. Patent No. 6,563,957 (“Li”), and/or knowledge of one skilled in the art [Appeal Brief filed February 4,

2008, “Grounds of Rejection to be Reviewed on Appeal,” pages 4 and 5).  
Correction of the Grounds of rejection to be reviewed on appeal for all  
claims is required.

### **EXAMINER’S ANSWER, GROUNDS OF REJECTION**

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner’s Answer mailed April 8, 2008 under the heading “Grounds of rejection” is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner’s Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading “New Grounds of Rejection” in the Examiner’s Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

Specifically, the Examiner’s Answer sets forth a rejection of claims 1-3, 10-15, 17, 18 and 20 as being rejected under 35 U.S.C. 102(e) as being anticipated by Quintana [page 3]; whereas the last Office action (Final Rejection mailed May 8, 2007), including any mailed Advisory Action(s), finds that, in addition to the §102(e) rejection:

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quintana in view of Keithley (U.S. Patent Number 6,028,677) [page 10];

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quintana in view of Keithley and further in view of Li (U.S. Patent 6,563,957) [page 11]; and

Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quintana [page 12].

Correction of all Grounds of rejection for all claims is required. This deficiency was previously noted in the Appeal Center Return dated January 18, 2008.

### **CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on February 4, 2008 defective;
- 2) to notify Appellant to file a paper properly addressing the Grounds of rejection of all claims;
- 3) for consideration of said paper; and
- 4) to vacate the Examiner's Answer mailed April 8, 2008;
- 5) to generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required; and
- 6) for such further action as may be appropriate.

Application No. 10/796,695

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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